

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

### **REMARKS/ARGUMENTS**

Claims 1-6 are currently pending in the application. Applicants have cancelled claims 3 - 5, and amended claims 1 - 2 and 6. Applicants request reconsideration of the application in light of the following remarks.

#### **Objections to the Specification**

The disclosure has been objected to for containing informalities. Applicants have amended the disclosure to address the Examiner's objection by replacing "the user and the host 10, 20" with "the user 10 and the host 20". Applicants respectfully request that the Examiner withdraw this objection.

#### **Objections to Claims**

The Examiner has objected to claim 6 for informalities. Applicants have amended claim 6 exactly as set forth by the Examiner in the Office Action by replacing "confirming the user whether he" in line 5 with "confirming whether the user" and omitting "he is" in line 6. Applicants respectfully request that the objections to claim 6 be withdrawn.

#### **Rejections under 35 U.S.C. §112**

Claims 1 - 3 and 6 stand rejected by the Examiner under 35 U.S.C. §112 as being indefinite. In accordance with this rejection, claim 3 has been cancelled without traverse. The objection to claim 3 is, therefore, obviated. Claims 1 - 2 and 6 have been amended and are now believed to conform with §112. Applicants respectfully request that the rejection of claims 1 - 3 and 6 under 35 U.S.C. §112 be withdrawn.

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

Claims 2 - 4 and 6 stand rejected by the Examiner under 35 U.S.C. §112 for antecedent basis issues. In accordance with this rejection, claims 3 - 4 have been cancelled without traverse. The objection to claims 3 - 4 is, therefore, obviated. Claims 2 and 6 have been amended and are now believed to conform with §112. Applicants respectfully request that the rejection of claims 2 - 4 and 6 under 35 U.S.C. §112 be withdrawn.

### **Rejections under 35 U.S.C. §103**

To establish a prima facie case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a prima facie case of obviousness. MPEP §2143.

#### Claims 1 and 4

Claims 1 and 4 were rejected under 35 U.S.C. § 103(a) as being anticipated by Bernstein et al. (U.S. Patent Publication No. 2004/0128356, hereinafter "Bernstein"), in view of Paarsmarkt et al. (U.S. Patent No. 6,118,856, hereinafter "Paarsmarkt"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claim 4 has been cancelled without traverse. The objection to claim 4 is, therefore, obviated.

Applicants claim in independent claim 1 (emphasis added) a system of simultaneously executing post office protocol e-mailing and chatting comprising, among other patentably distinct

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

features, “a CHmail (chatting-mailing) server for simultaneously executing post office protocol e-mailing and chatting between the sender and the receiver through a log-in ID of the CHmail server, an IP address/host name, and a port number for identifying a chatting attempter inserted in a header of the e-mail”. As a main advantage, the email itself, which is composed by inserting the specific information into the header of an email through a CHmail program, could always be capable of having the email sender connected to the email receiver for chatting.

In contrast, Bernstein only uses email addresses that anyone can access instead of conventional “screen names” to recognize the recipients of chatting (paragraphs [004-006] and [0014-0015]). Bernstein states that the sender’s email address must be included as part of the email and that the email address may be stored in a cookie on a computer (paragraph [0123]). This means Bernstein only uses the email address included in an email to recognize the recipients of chatting. Therefore, Bernstein does not utilize a log-in ID of the CHmail server, an IP address/host name, and a port number as claimed by Applicants. Furthermore, in Bernstein, a standard email program is used to send an “IM Enhanced” email (paragraphs [0015-0016]). A standard email program cannot insert any specific information into an email header other than the standard general information of an email such as an email address of the sender, an email address of the receiver, date, etc. Therefore, Bernstein does not insert anything into email headers and never modifies email header information of emails for their purpose.

Likewise, Paarsmarkt only uses the content of a received email itself to forward a portion of the received email to a remote device. Therefore, Paarsmarkt also never inserts any identifying elements such as a log-in ID of the CHmail server, an IP address/host name, and a port number as claimed by Applicants into email headers for their purpose.

Even if it was proper to modify Bernstein in light of Paarsmarkt, and that it would be successful, which Applicants doubt, the combination still does not teach “a log-in ID of the CHmail server, an IP address/host name, and a port number for identifying a chatting attempter”, let alone those elements “inserted in a header of the e-mail” as required by independent claim 1.

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

Thus, focusing on Applicants claimed invention in claim 1 as a whole, it is clear that Applicant's claimed invention is more than just a trivial step forward in the art, but is a bona fide, nonobvious technical accomplishment or advance in the art. Therefore, without the benefit of Applicant's disclosure, the foregoing specific combination of features claimed by Applicant in independent claim 1 would not be known.

Applicants respectfully request that the obviousness rejection of claims 1 and 4 be withdrawn.

#### Claim 2

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein, in view of Yamaguchi (U.S. Patent No. 6,499,055, hereinafter "Yamaguchi"), and in further view of Apfel et al. (U.S. Patent No. 6,405,225, hereinafter "Apfel"), yet in further view of Paarsmarkt. Applicants respectfully traverse this rejection and request reconsideration of the claims.

Applicants claim in independent claim 2 (emphasis added) a method of simultaneously executing post office protocol e-mailing and chatting comprising, among other patentably distinct steps: "framing an e-mail after turning on a CHmail program that simultaneously executes post office protocol e-mailing and chatting; granting a port number through a CHmail server; inserting a log-in ID of the CHmail server, an IP address/host name, and a the port number into the header of the e-mail through the CHmail program". As a main advantage, the email itself, which is composed by inserting the specific information into the header of an email through the CHmail program, could always be capable of having the email sender connected to the email receiver for chatting.

In contrast, as set forth above, Bernstein only uses email addresses that anyone can access instead of conventional "screen names" to recognize the recipients of chatting (paragraphs [004-006] and [0014-0015]). Bernstein states that the sender's email address must be included as part of the email and that the email address may be stored in a cookie on a computer (paragraph

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

[0123]). This means Bernstein only uses the email address included in an email to recognize the recipients of chatting. Therefore, Bernstein does not utilize a log-in ID of the CHmail server, an IP address/host name, and a port number as claimed by Applicants. Furthermore, in Bernstein, a standard email program is used to send an "IM Enhanced" email (paragraphs [0015-0016]). A standard email program cannot insert any specific information into an email header other than the standard general information of an email such as an email address of the sender, an email address of the receiver, date, etc. Therefore, Bernstein does not insert anything into email headers and never modifies email header information of emails for their purpose.

Likewise, Paarsmarkt only uses the content of a received email itself to forward a portion of the received email to a remote device. Therefore, Paarsmarkt also never inserts any identifying elements such as a log-in ID of the CHmail server, an IP address/host name, and a port number as claimed by Applicants into email headers for their purpose.

Although Yamaguchi mentions an IP address, this IP address means the IP address of the email server, not the IP address of the computer of the email sender. Furthermore, Yamaguchi does not disclose inserting anything into email headers. Apfel is also using the email address of the Carbon Copy to identify the Carbon Copy. Therefore, Apfel is also not inserting anything into the email header at all.

Even if it was proper to modify Bernstein in light of Paarsmarkt, Apfel, and Yamaguchi, and that it would be successful, which Applicants seriously doubt, the combination still does not teach "inserting a log-in ID of the CHmail server, an IP address/host name, and a the port number into the header of the e-mail through the CHmail program" as required by independent claim 2.

Thus, focusing on Applicants claimed invention in claim 2 as a whole, it is clear that Applicant's claimed invention is more than just a trivial step forward in the art, but is a bona fide, nonobvious technical accomplishment or advance in the art. Therefore, without the benefit of Applicant's disclosure, the foregoing specific combination of features claimed by Applicant in independent claim 2 would not be known.

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

Applicants respectfully request that the obviousness rejection of claim 2 be withdrawn.

Claims 3 and 5

Claims 3 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein, in view of Sanne (U.S. Patent No. 6,295,536, hereinafter “Sanne”), and in further view of Hoyle (U.S. Patent No. 6,771,290, hereinafter “Hoyle”).

Claims 3 and 5 have been cancelled without traverse. The objection to claims 3 and 5 is, therefore, obviated. Applicants respectfully request that the obviousness rejection of claims 3 and 5 be withdrawn.

Claim 6

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein, in view of Cybul (U.S. Patent No. 6,246,997, hereinafter “Cybul”), and in further view of Apfel. Applicants respectfully traverse this rejection and request reconsideration of the claims.

Applicants claim in independent claim 6 (emphasis added) a goods publicity method using simultaneously executing post office protocol e-mailing and chatting at the same time between a user and a host on an Internet shopping mall comprising, among other patentably distinct steps: “inserting a log-in ID of a CHmail server, an IP address/host name, and a port number into a header of an e-mail through a CHmail program; sending the e-mail to the host using the CHmail program simultaneously executing e-mailing and chatting at the same time after selecting goods”. As a main advantage, the email itself, which is composed by inserting the specific information into the header of an email through the CHmail program, could always be capable of having the email sender connected to the email receiver for chatting.

In contrast, as set forth above, Bernstein only uses email addresses that anyone can access instead of conventional “screen names” to recognize the recipients of chatting (paragraphs [004-006] and [0014-0015]). Bernstein states that the sender’s email address must be included as part

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

of the email and that the email address may be stored in a cookie on a computer (paragraph [0123]). This means Bernstein only uses the email address included in an email to recognize the recipients of chatting. Therefore, Bernstein does not utilize a log-in ID of the CHmail server, an IP address/host name, and a port number as claimed by Applicants. Furthermore, in Bernstein, a standard email program is used to send an "IM Enhanced" email (paragraphs [0015-0016]). A standard email program cannot insert any specific information into an email header other than the standard general information of an email such as an email address of the sender, an email address of the receiver, date, etc. Therefore, Bernstein does not insert anything into email headers and never modifies email header information of emails for their purpose.

Likewise, Cybul does not disclose inserting anything into email headers. Apfel is also using the email address of the Carbon Copy to identify the Carbon Copy. Therefore, Apfel is also not inserting anything into the email header at all.

Even if it was proper to modify Bernstein in light of Cybul and Apfel, and that it would be successful, which Applicants doubt, the combination still does not teach "inserting a log-in ID of a CHmail server, an IP address/host name, and a port number into a header of an e-mail through a CHmail program; sending the e-mail to the host using the CHmail program simultaneously executing e-mailing and chatting at the same time after selecting goods" as required by independent claim 6.

Thus, focusing on Applicants claimed invention in claim 6 as a whole, it is clear that Applicant's claimed invention is more than just a trivial step forward in the art, but is a bona fide, nonobvious technical accomplishment or advance in the art. Therefore, without the benefit of Applicant's disclosure, the foregoing specific combination of features claimed by Applicant in independent claim 6 would not be known.

Applicants respectfully request that the obviousness rejections of claim 6 be withdrawn.

Appl. No.: 09/859,568  
Amdt. dated: January 10, 2005  
Reply of Office action of September 8, 2004

Docket No. HAHA-0218

### Conclusion

In summary, and in view of the amendments herein, none of the references cited by the Examiner or any other known prior art; either alone or in combination, disclose the unique combination of features disclosed in applicant's claims presently on file. For this reason, allowance of all of applicant's claims is respectfully solicited.

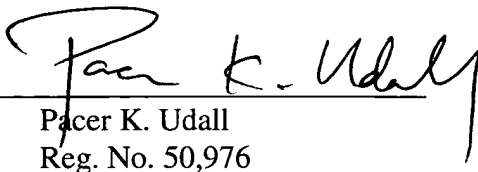
Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

It is requested that a one-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$55.00 is enclosed herewith.

If any other fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Dated: January 10, 2005

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